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IN THE
SUPREME COURT OF THE UNITED
STATES.

OCTOBER TERM, 1922.

No. 918

THE UNITED STATES OF AMERICA,
ex relatione, THE BALDWIN
COMPANY,

Petitioner,
Appellant,

vs.

THOMAS E. ROBERTSON, as Com-
missioner of Patents, and R.
S. HOWARD COMPANY, in-
tervenor.

**BRIEF ON BEHALF OF R. S. HOWARD
COMPANY.**

Statement of the Case.

This action was brought to enjoin the Com-
missioner of Patents from cancelling two Trade-

Mark Registrations, viz: Trade-Mark Registration No. 31,411 registered March 8, 1898, by the Valley Gem Piano Company, and Trade-Mark Registration No. 46,993 registered October 17, 1905 by The Baldwin Company. Both of said marks were for pianos and both registrations were claimed to be owned by The Baldwin Company.

Registration No. 31,411 is for the registration of the mark reproduced on page 53-r of the Record; the essential features of this mark are the common surname "Howard" and the initials "VGPCo." arranged in a monogram.

Registration No. 46,993 is for the mark reproduced on page 53-p of the Record, and consists solely of the common surname "Howard".

The "10-year" clause of Sec. 5 of the Trade-Mark Act of 1905 is not involved at bar, because The Baldwin Company does not claim use of the mark for the requisite "10-year" period.

In August, 1914, the R. S. Howard Company brought proceedings against The Baldwin Company to have cancelled the said two Trade-Mark Registrations and the Court of Appeals of the District of Columbia in *R. S. Howard Company vs. The Baldwin Company* (48 App. D. C., 437; Rec. pp. 61-65 adjudged that both said marks were incapable of registration, that said R. S. Howard Company was damaged by said registrations and that both said registrations should be cancelled; appeals to this Court were dismissed and petitions for writs of certiorari were denied (256 U. S. 35; 41 Supp. Ct. Rep., 405).

Before the decision of the Court of Appeals of the District of Columbia in said cancellation

proceedings had been certified to the Commissioner of Patents, as provided by Sec. 4914 Rev. Stat., The Baldwin Company filed its bill of complaint, at bar, against the Commissioner of Patents, in the Supreme Court of the District of Columbia, alleging that it would be damaged by the cancellation of said trade-mark registrations and that the said R. S. Howard Company had not been, and could not be, damaged by said trade-mark registrations, and prayed that the Commissioner of Patents be enjoined from cancelling said trade-mark registrations, *pendente lite* and perpetually.

The claim for such injunction was based wholly upon the allegations that the R. S. Howard Company is not, and could not be, damaged or injured by said Trade-Mark Registrations, and that The Baldwin Company is entitled to have this claim "judicially determined" under Sec. 4915 U. S. Rev. Stat.

The grounds alleged for such an injunction are identical with those alleged, and adjudicated adversely to The Baldwin Company, in said Cancellation proceedings of *R. S. Howard Company vs. The Baldwin Company* (48 App. D. C. 437; Rec. pp. 61-65; 256 U. S. 35), and the relief prayed for at bar is the same relief which was *expressly denied* to The Baldwin Company in the Equity suit in the Second Circuit of *The Baldwin Company v. R. S. Howard Company* (See pp. 26-29, *infra*).

Motion to Dismiss.

The R. S. Howard Company intervened in the action at bar, filed its answer, and moved to dismiss the bill of complaint on the following grounds (Rec. p. 65):

(a) That the bill was bad in substance and insufficient in law;

(b) That the Supreme Court of the District of Columbia was without power or authority to grant the relief prayed for, or any relief in the premises;

(c) That all issues involved in the action were *res adjudicata* as appeared from the allegations and admissions contained in the bill of complaint and the matters of record filed as a part of the answer of the R. S. Howard Company.

All the separate grounds, above stated, were urged and argued at length, below, and unmistakably show a want of equity.

Respondent urges that if the ground of the decision below is not well taken, the record discloses other good and sufficient grounds. *Cole v. Ralph*, 252 U. S. 286, 290.

I.

The complaint is bad in substance and insufficient in law.

The complaint fails to state a good cause of action.

The only "right" claimed at bar, and the only matter in dispute, is the right to have the common surname "Howard" registered as a trade-mark.

That a common surname cannot be exclusively appropriated, or registered, as a trade-mark has been positively foreclosed by the repeated decisions of this Court.

Howe Scale Co. v. Wyckoff, Seamans & Benedict, 198 U. S., 118;

Merriam Co. v. Syndicate Pub. Co., 237 U. S., 618; and cases cited therein.

Any contention based upon such a claim is manifestly frivolous.

Newburyport Water Co. v. Newburyport, 193 U. S., 561;

Merriam Co. v. Syndicate Pub. Co., 237 U. S., 618;

Equitable Life Assur. Soc. v. Brown, 187 U. S., 308.

The "10-year" clause is not involved.

The claim that "Howard" is displayed in a "particular" or "distinctive" manner is also frivolous; see pp. 13-15, *infra*.

Baldwin Company not the first to use "Howard".

The Baldwin Company was not the first to use "Howard" as a mark for pianos. The Record shows, without contradiction, that Robert S. Howard, the organizer and predecessor in business of the R. S. Howard Company was continuously selling

pianos made by the New England Piano Company of Boston, Mass., from 1889 to 1896 which were marked "Howard, New York", "R. S. Howard & Co., Boston"; also "Howard & Co., Boston", beginning in 1893 (Howard's testimony, Rec. p. 24; Scanlan's testimony, Rec. p. 25).

Judge Hough finds that *prior to 1896*

"there were thousands sold under the title 'R. S. Howard & Co.', 'Howard, New York', 'Howard & Co., Boston', and 'R. S. Howard & Co., Boston'", and that "no other salesman except Howard sold pianos with the 'Howard' mark upon them. * * * There is no doubt that from the time any variance of 'Howard' was inscribed upon pianos, the retail trade, the user and the public generally, spoke of them as 'Howard' pianos" (Rec. p. 47).

The New England Piano Company never claimed to own the mark or brand "Howard" on pianos, but, on the contrary, recognized that it belonged to Robert S. Howard (Rec. pp. 25, 26).

The Record in the Cancellation proceedings contains the testimony of twenty four witnesses who sold, handled or knew about pianos marked "Howard" (either "Howard", "R. S. Howard & Co.", or "Howard & Co.") sold by Robert S. Howard *prior to 1896* (Rec. pp. 23-26, 36-41).

The Baldwin Company must Establish an Affirmative Right.

To entitle the Baldwin Company to relief (to any relief) it must show, in itself, the existence of a right, something to which he is lawfully entitled and which he may lawfully claim.

Whether or not the R. S. Howard Company is damaged by said registrations is wholly immaterial.

As the Baldwin Company seeks affirmative relief, it must establish an affirmative right. This Court has said:

"It necessarily follows that no adjudication (under Sec. 4915 R. S.) can be made in favor of the applicant unless the alleged invention for which a patent is sought is a patentable invention", and it must be shown that "the applicant is entitled, according to law, to receive a patent". *Gandy v. Marble*, 122 U. S., 432.

Butterworth v. Hoe, 112 U. S., 50;
Hill v. Wooster, 132 U. S., 693.

The same must hold good as to a trade-mark, if Sec. 4915 R. S. applies to trade-marks.

In *Hill v. Wooster*, *supra*, patent was refused under Sec. 4915 R. S. because the alleged invention was not a patentable invention, although the pleadings presented only the question of *priority of invention* and all the tribunals below decided the case solely on the issue of priority.

In *Curtiss Aeroplane Corp. v. Janin*, 278 Fed. (C. C. A.) 454, an action under Sec. 4915 R. S., the Court said:

"As was pointed out in *Hill v. Wooster*, 132 U. S., 693, 10 Sup. Ct., 228, L. Ed., 502, it is the duty of the Court, in proceedings under Rev. Stat. Sec. 4915, not only to decide priority as between rival claims to invention, but to ascertain whether the parties or either of them has made a patentable invention".

In a suit under Sec. 4918 R. S., which is, in substance, an interference suit to determine priority of invention, it has been repeatedly held that the Courts will not engage in a useless investigation of priority, if there is no patentable invention involved, but will dismiss the complaint. *International Signal Co. v. Freeland Apparatus Co.*, 278 Fed. (C. C. A.) 468, 470, and numerous cases therein cited.

Hence, it is respectfully submitted that if Sec. 4915 R. S. applies to trade-marks (which is one of the questions here in dispute), then no adjudication can be made in favor of a plaintiff unless the alleged marks which it seeks to register, or to continue upon the Register, are registrable marks; that is, plaintiff at bar must show that it is entitled, "*according to law*", to have its said marks on the Register of Trade-Marks.

No Property right in a Trade-Mark Registration.

Property rights in a mark are not created by registration or by the Trade-Mark Acts, but must already be in existence under the common-law before entitled to the benefits of the Registration Acts. Registration confers no title, and there is no vested right, or vested right of property, in trade-mark registrations, and registration creates no new right or title.

Trade-Mark Cases, 100 U. S., 52, 92, 93;
Hanover Star Milling Co. v. Metcalf, 240
 U. S., 403;
United Drug Co. v. Theo. Rectanus Co.,
 248 U. S., 90.

**Fifth Amendment of the Constitution
does not apply.**

A registrant cannot be deprived, in a legal sense of the benefits of registrations or damaged by the cancellation of registrations if he were never entitled to register the marks, as is self-evident. A "right" which never existed cannot be violated.

"Rights" unlawfully obtained cannot *confer* "rights" which can be protected by the Fifth Amendment (or any other Article) of the Constitution.

The claim that the Fifth Amendment applies is manifestly frivolous; it is without color of merit.

Amer. R. Co. v. Castro, 204 U. S., 453;
Kent vs. Porto Rico, 207 U. S., 113, 117;
Defiance Water Co. v. Defiance, 191
U. S. 184, 190, 191.

**Trade-Mark Registration Provisions are all
Statutory and Arbitrary.**

All provisions relating to the registration of trade-marks are wholly statutory and may be modified or entirely withdrawn at any time at the will of Congress; there are no general principles or substantive law applicable and all statutory provisions relating to the registration of trademarks are wholly arbitrary. For example, the so-called "10-year" clause of Section 5 of the present Trade-Mark Act which admits to registry marks which were not common-law or tech-

nical trade-marks which had been in "actual and exclusive use" for 10 years next preceding the passage of the Act which benefits only those who have used such marks for a continuous 10-year period *prior* to February 20, 1895; another arbitrary exercise was the amendment preventing the future registration of the symbol of the American National Red Cross, making no provision for cancelling those already registered, but allowing any person already using the symbol to continue its use; another exercise of this arbitrary power, without any regard to any rules of technical trade-mark law, was the amendment of January 8, 1913, which prevented the registration of any "name, distinguishing mark, character, emblem, colors, flag or banner adopted by any institution, organization, club, or society which was incorporated prior to the date of adoption and use by the applicant", etc. The Trade-Mark Act expressly prohibits the registration of the name of an "individual, firm, corporation or association" except when "written, printed, impressed or woven in some particular or distinctive manner or in association with the portrait of the individual", or has been "in actual and exclusive use as a trade-mark" for 10 years prior to February 20, 1905.

Registration at best is but a *privilege*. It is within the power of Congress to withhold it altogether or grant it to such an extent, with such duration, and to such classes of marks or persons, and with such benefits and advantages, and subject to such conditions and limitations as it may please. That is, the right to register is wholly statutory and the powers of the Courts and the

executive departments of the Government are positively bound by the confines of the statutes, and the cancellation paragraph (See. 13) of the Trade-Mark Act should be left in the status where Congress placed it, that is, wholly within the exclusive jurisdiction of the Patent Office and the Court of Appeals of the District of Columbia. It is well settled law that no right of review exists unless expressly conferred by statute. (*In re Hien*, 166 U. S., 432). As this Court said in *Baldwin Company vs. Howard Company* (256 U. S., 35), wherein the various statutory sections relating to registration of trade-marks were referred to:

“No provision is made which permits this statutory proceeding to be carried beyond the decision of the Court of Appeals of the District of Columbia.”

The limitations of the registration Acts have been enforced by the Courts in a strict manner as is illustrated by a host of cases of which the following are a few:

Stark Bros. v. Stark, 41 Sup. Ct. Rep., 221. Held: No damages can be recovered in an action for infringement of registered trade-mark except on proof that defendant was notified of the registration by actual notice or constructive statutory notice by marking the goods as required by the statute, and notice to “discontinue the unfair competition and infringement of our rights” not sufficient as a basis to recover damages under the Trade-Mark Statute.

Elgin Nat'l. Watch Co. v. Illinois Watchcase Co. 179 U. S., 665. Held: Where a word or name had been granted registration improperly, the

registration conferred no rights or benefits under the Trade-Mark Statutes. "He can register only what he has used".

Ryder v. Holt, 128 U. S., 525. Held: Where bill did not allege that the mark was used by defendant on goods intended to be transported to a foreign country, the Federal Court had no jurisdiction, and where proof of that fact was not presented the bill was dismissed. *Warner v. Scarle & Hereth Co.*, 191 U. S., 195, to the same effect.

Corbin v. Gould, 133 U. S., 308. Held: That use and registration of the words "The Tycoon Tea" enclosed in a diamond shaped figure, "the essential features of which are the symbol of a diamond and the arbitrary selected word 'Tycoon'", conferred no exclusive right to the word "Tycoon" *simpliciter*.

Ammon & Person v. Narrangansett Dairy Co., 252 Fed., 276, 262 Fed. (C. C. A.) 880. Held: That use of "Queen of the West" did not show the prerequisite statutory use to authorize the registration of "Queen", and the defendant held not guilty of infringement of the registered trademark "Queen", although the defendant used "Queen" on goods of the same description; the defendant was held guilty of unfair trade competition.

Diederich v. Schneider Co., 195 Fed. (C. C. A.) 31. Held: That one acquires no right in a registered trade-mark unless the mark is used on a vendable commodity, and a registered mark cannot be infringed, that is, plaintiff can have no relief under the trade-mark statutes, unless the mark is placed by the defendant on a vendable commodity sold or intended to be sold in commerce.

among the States, foreign nations or Indian tribes; *Warner v. Scarle & Hereth Co.*, 191 U. S., 195, to same effect.

Bronson v. Duell, 17 App. D. C., 471. Held: "The lawful right to convert a mark or symbol into a trade-mark was intended to remain a prerequisite to registration", and that the mark must be such a mark as could be lawfully exclusively appropriated.

"These are questions not of natural but purely statutory right * * *. No Court can disregard any statutory provisions in respect of these matters on the ground that in its judgment they are unwise or prejudicial to the interests of the public". *United States v. Amer. Bell Tel. Co.*, 167 U. S., 224, 246 (respecting patent statutes).

"The general powers of Federal Courts when sitting as Courts of equity * * * can be exerted only in cases otherwise within the jurisdiction of those Courts as defined by Congress". *Briggs v. United Shoe Mach. Co.*, 239 U. S., 48, 50, (Van Devanter, J.) in holding that the equity powers of the Courts in actions under Sec. 4915, 4920 R. S. were limited to those defined by Congress in those Sections.

"Howard" not in a "Particular" or "Distinctive" Manner.

"Howard" in said registrations is not written or impressed in a particular or distinctive manner as required by the Trade-Mark Statute. This

needs no argument. The drawings of the Trade-Mark Registrations to be cancelled (Rec. pp. 53-r, 53-p) speak for themselves.

"Peculiarities in printing cannot lend trade-mark properties to an otherwise unregistrable descriptive word (or personal name.) If it were otherwise, an unregistrable non-technical word could be appropriated and registered as a trade-mark as many times as the form of its printing could be varied." *Johns-Manville Co. v. Am. Steam Packing Co.*, 33 App. D. C. 234.

Oliver Plow Works v. Oliver Mfg. Co.,
40 App. D. C., 125.

A mark is not registrable unless its controlling or dominant features are registrable.

Chapman v. Wintroath, 40 Sup. Ct. Rep.,
234;
In re Crescent Typewriter Supply Co.,
30 App. D. C., 324;
Johnson v. Brandeau, 30 App. D. C., 348;
In re Hopkins, 29 App. D. C., 118.

To permit the registration of "Howard" to stand opens the door to imposition, fraud and oppression, and to do precisely what has been done by The Baldwin Company, viz: disclaim "Howard" here as a mark except when written in "Old English" but everywhere else, under all other circumstances, to claim "Howard" in every form—that is, the *exclusive* right to use "Howard", and IN ANY FORM and EVERY FORM of lettering.

An attempt to prevent the cancellation of said registrations is equivalent to a threat to enforce the penalties provided by the registration statutes, and a refusal to cancel is equivalent to ruling that the Baldwin Company has the *exclusive* right to the personal name "Howard". *McIlhenny Sons v. Trappey*, 278 Fed. 582.

Attention is respectfully requested to the certificate of registration (Rec. p. 53-s) No. 31,411, wherein it is stated that "the panel and form of lettering of 'Howard' may be differently arranged without wholly altering the character of the trade-mark, the principal feature of which is the word 'Howard' in connection with the initials 'VGP Co.' arranged monogrammatically."

In the application to register, which resulted in Registration No. 46,993, substantially the same wording is found. (Rec. p. 53-a). The first drawing (Rec. p. 53-o) originally filed with this application was substantially a duplicate of the drawing shown in Registration No. 31,411, and the statement contained the following:

"the form of lettering of 'Howard' may be differently arranged without materially altering the character of the trade-mark, the principal feature of which is the word 'Howard'".

Comparison is also respectfully requested between the lettering of the name "Howard" appearing in the registrations with the piano markings reproduced in the Record, pages 42-e, 42-d, 42-f. which reproductions the officers of the Baldwin Company testified are the only markings for "Howard" pianos used by that Company since 1912 (Sargent's testimony, Rec. pp. 31, 32;

McGee's testimony, Rec. p. 36). It will be noted that the lettering of the name "Howard" is different in each of the markings and also that each marking is different from the lettering of the mark used prior to 1912, which last mentioned mark is reproduced in Rec. page 42-e.

Action at Bar Was Not Brought in Time.

If it should be held that Section 4915 R. S. is applicable to trade-marks, it is respectfully submitted that the case at bar was not brought in time.

This Court, in *Gandy v. Marble*, 132 U. S., 432, held that an action under Section 4915 R. S. must be begun "within one year after any action therein"; that is, after refusal of a patent by the Commissioner or of the Court of Appeals of the District of Columbia, and that such was the requirement of Section 4894 R. S.

Gandy v. Marble, 122 U. S., 432; 7 Sup. Ct., 1290;

In re Hien, 166 U. S., 432, 438;

Westinghouse Co. v. Ohio Brass Co., 186 Fed. 518;

Colman v. Amer. Co., 235 Fed., 531.
(Certiorari denied);

McKnight v. Metal etc. Co., 128 Fed., 51.

In re Hien, 166 U. S., 432, 438, this Court said of *Gandy v. Marble, supra*:

"It was held that the bill in equity (under Section 4915 R. S.) was *sub modo* a branch of the application for the patent and

was governed by the rule as to laches and delay declared by Section 4894".

Section 4894 states in part:

"upon failure of the applicant to prosecute the same within one year after any action therein, of which notice shall have been given to the applicant, they shall be regarded as abandoned by the parties thereto, unless it can be shown to the satisfaction of the Commissioner of Patents that such delay was unavoidable.

In *Westinghouse Elec. Co. v. Ohio Brass Co.*, 186 Fed., 518, where a bill of complaint brought under Section 4915 R. S. was dismissed, the Court said:

"The failure of complainants to institute the present proceedings within one year after the last official action on their application for Letters Patent, viz, the adverse decision of the Court of Appeals of the District of Columbia, is a bar to such proceedings."

Sutton v. Wentworth, 247 Fed. (C. C. A.) 493, 502.

In the cases cited, it was held that the time began to run "on the day it (the decision of the Court of Appeals of the District of Columbia) was rendered by that Court".

The decision and order of the Court of Appeals of the District of Columbia which was the "last action" in said cancellation proceedings

was made March 3, 1919 (Rec. p. 65), and the bill of complaint at bar was filed May 7, 1921 (Rec. p. 11).

Under the decisions above cited, to take advantage of Section 4915 R. S. (assuming that it applies to trade-marks) the bill of complaint at bar should have been filed within one year from the date of the decision of the Court of Appeals of the District of Columbia in said cancellation proceedings.

The appeals of The Baldwin Company to the Supreme Court of the United States which were dismissed for want of jurisdiction and its applications for writs of certiorari which were denied (256 U. S. 35) cannot be held to have extended the time within which to file the bill of complaint at bar.

In *Westinghouse Elec. Co. v. Ohio Brass Co.*, 186 Fed., 518, where proceedings under Section 4915 R. S., were first brought in the wrong district, and afterwards brought in the right district but not until more than a year had elapsed after the decision of the Court of Appeals of the District of Columbia, the Court, in dismissing the proceedings, said:

“Nor did the institution of proceedings within the year in the United States Circuit Court for the Western Division of the Northern District of Ohio satisfy the requirements of Section 4894. That requirement is to prosecute the application, and that presupposes that action be taken in the right tribunal and against the right party”.

“These proceedings, if they had been in time, amounted to the taking of an appeal,

but as they were not initiated and prosecuted within the time limited they were ineffectual". *In re Hien*, 166 U. S., 432, 437, adjudging an appeal to the Court of Appeals of the District of Columbia from a decision of the Commissioner of Patents not taken in 40 days was too late.

In cases involving time-limits under which writs of certiorari are returnable, or appeals taken, it has been repeatedly held that it is imperative that such actions be taken within the time limited.

"The statute imperatively requires that the right remedy should be invoked within the time limited". *Darnell v. Ill. Cent. R. Co.*, 206 Fed. (C. C. A.) 445, in which many cases are cited and the question discussed at length.

II.

The Supreme Court of the District of Columbia was without power or authority to grant the relief prayed for, or any relief in the premises.

The Court is respectfully referred to the Opinion of the Court of Appeals of the District of Columbia in the case at bar dismissing the bill of complaint, where this question is carefully discussed. (See opinion in record p. 79).

It is unmistakably plain that Sec. 4915 R. S., by its wording and by its history, pertains solely to

patents, and that it does not include trade-marks.

The power and authority to cancel a trade-mark registration is granted by the Trade-Mark Statutes EXCLUSIVELY to the Commissioner of Patents subject only to review by the Court of Appeals of the District of Columbia, except in the case of interfering registrations where remedy is provided under Sec. 22 of the Trade-Mark Act of 1905.

Even though it be assumed that Sec. 4915 R. S. authorizes a bill in equity to secure a trade-mark registration, it does not follow that it authorizes the cancellation of a trade-mark registration. Section 4915 R. S. does not authorize the cancellation of a patent; a patent can only be cancelled by the United States under the authority of Sec. 4920 R. S. (*United States v. Bell Telephone Co.*, 128 U. S., 315, 368, 369; *United States v. Am. Bell Telephone Co.*, 159 U. S., 548, 555).

The question is wholly one of statutory power and statutory construction. Congress has dictated what rule and what Court shall control, and even should plaintiff's contentions appear meritorious "they cannot prevail against the provisions of the statutes. (*U. S. v. Amer. Bell Tel. Co., supra*)", "for the whole subject is one of statutory origin and regulation", (*Chapman v. Wintroath*, 40 Sup. Ct. Rep., 234), and subject to all the restrictions congress has provided.

In *Butterworth v. Hoe*, 112 U. S., 50, and in *United States v. Duell*, 172 U. S., 576, this Court described and summarized all the instrumentalities provided by Congress since the foundation of the Government for the granting of patents and

traces the development of appeals, viz: in 1793 appeals might be taken to three arbitrators; in 1836 appeals might be taken to a Board of examiners composed of three disinterested persons whose decision was to be certified to the Commissioner of Patents, who "shall be governed thereby in further proceedings to be had on such application", also remedy by bill in equity between interfering patents or whenever an application had been refused by the Board of Examiners (much the same as Sections 4918 and 4915 R. S.); in 1839, as modified in 1852, where an appeal was allowable by law to the Board of Examiners, the applicant instead thereof had the right to appeal to the Chief Judge or to either of the assistant Judges of the Circuit Court of the District of Columbia and the remedy by bill in equity was extended to all cases where patents were refused for any reason whatever; in 1861 the board of examiners, substantially as now constituted, was created with appeal to the Judges, as before; in 1870 an appeal to the Supreme Court of the District of Columbia sitting in banc was substituted for the appeal to the Judges, "whose decision was to govern further proceedings in the case"; in 1893 appeals were transferred from the Supreme Court of the District of Columbia sitting in banc to the Court of Appeals of the District of Columbia, which is the present status.

It is difficult to imagine in what words See. 4915 R. S. could be more explicitly stated; not the slightest indication exists that the section includes, or applies to, trade-mark registrations.

**Previous Registration Applications under
Sec. 4915.**

In none of the cases mentioned in the petition, where attempts have been made to secure trade-mark registrations by bill in equity under Sec. 4915 R. S., has these efforts been successful.

In *Old Lexington Club Dist. Co. v. Kentucky Dist.* (1916) "Old Lexington Club" for whiskey, 234 Fed., 464; aff. 247 Fed., 1005; registration denied, jurisdictional question not raised.

In *Hercules Powder Co. v. Newton, Commissioner of Patents*, (1918), "Infallible" for powder, 254 Fed., 906; aff. 266 Fed., 169; registration refused; defendant "consents to the jurisdiction of the Court above named to hear and determine said action as a Court of original jurisdiction".

In *American Steel Foundries vs. Robertson, Commissioner*, No. 291, October Term, 1922 of this Court; "Simplex" for railway car devices; jurisdictional question raised and complaint dismissed.

In *Loughran v. Quaker City Chocolate Co.*, 286 Fed. 694, 698, the Court expressly held that it was without jurisdiction to cancel a trade-mark registration.

As has frequently been stated by the Courts, patents and trade-marks have little in common. Patent grants and trade-mark registrations are under different constitutional provisions, all Acts of Congress relating to patent grants and trade-mark registrations are separate, and distinctly different, and the property rights secured by patent grants and the benefits and advantages obtained by trade-mark registrations are vastly

different. As this Court said in *Trade-Mark Cases*, 100 U. S., 82, 93, 94:

"Any attempt, however, to identify the essential characteristics of a trade-mark with inventions and discoveries in arts and science or with the writings of authors, would show that the effort is surrounded with insurmountable difficulties.

"The ordinary trade-mark has no necessary relation to invention or discovery, * * *. It is often the result of accident rather than design, and when under the Act of Congress it is sought to establish it by registration, neither originality, invention, discovery, science nor art is in any way essential to the right conferred by that Act. * * * trademarks have sometimes been likened to letters patent and sometimes to copyrights from both of which they differ in many respects. And I think * * * 'much confusion has arisen from similitudinary reasonings on the subject'".

A trade-mark may be and usually is wholly destitute of originality, whereas originality is a primary essential of a patent.

It is respectfully submitted that to hold that Sec. 4915 R. S. applies to trade-marks would be "judicial legislation", so often condemned by this and other Courts (*Trade-Mark Cases*, 100 U. S. 82, 95).

It is "familiar doctrine that 'when a statute creates a new offense and denounces the penalty, or gives a new right and declares the remedy, the punishment or the remedy can be only that

which the statute prescribes'". *Wilder Mfg. Co. v. Corn Products Co.*, 236 U. S., 165, 174, 175, and cases therein cited.

"When a statute creates a new right or offense and provides a special remedy or punishment, they alone apply, such provisions are exclusive". *Barnett v. National Bank*, 98 U. S., 555, 558.

United States v. Babcock, 250 U. S., 328.

Jurisdiction.

"Jurisdiction may be defined to be the right to adjudicate concerning the subject-matter in the given case. To constitute this there are three essentials: First, the Court must have cognizance of the class of cases to which the one to be adjudged belongs; second, the proper parties must be present; third, the point decided must be, in substance and effect, within the issue." *Reynolds v. Stockton*, 140 U. S., 254.

"It is a familiar principle that, though a tribunal may have no power to grant the relief asked, it has jurisdiction to hear and determine the question of power".

As the right of cancellation, as well as of registration is strictly a statutory right and strictly limited and controlled by the statutory remedy provided by Section 13 of the Trade-Mark Act of 1905, and as it plainly appears that the Supreme Court of the District of Columbia has no "cognizance of the class of cases" to which the case

at bar belongs, the Supreme Court of the District of Columbia was without authority or power to grant the injunction appealed from or any relief in the premises.

"The Circuit Court being without jurisdiction to entertain the bill in equity for an injunction, all its proceedings in the exercise of the jurisdiction which it assumed are null and void. The restraining order, in the nature of an injunction, it had no power to make * * *.

"Where a Court has jurisdiction, it has a right to decide every question which occurs in the case; and whether its decision be correct or otherwise, its judgment until reversed, is regarded as binding in every other Court. But if it acts without authority, its judgments and orders are regarded as nullities. They are not voidable, but simply void". *In re Sawyer*, 124 U. S., 200, 220.

Windsor v. McVeigh, 93 U. S., 274;
Elliott v. Peisal, 1 Pet. 328, 340;
Langford v. Monteith, 102 U. S., 145;
Ex parte Lange, 18 Wall., 163, 176;
United States v. Walker, 109 U. S., 259;
Thompson v. Whitman, 18 Wall., 457,

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Where it appears that there is no ground for relief, the Appellate Court may finally dispose of the merits upon an appeal from an interlocutory order and dismiss the bill.

Eagle Glass Mfg. Co. v. Rowe, 245 U. S., 275, 280;

Smith v. Vulcan Iron Works, 165 U. S., 518;
Metropolitan Co. v. Kaw Valley District, 223 U. S., 523;
U. S. Fidelity Co. v. Bray, 225 U. S., 214.

On appeal from an interlocutory order the Court "may direct the bill to be dismissed if it appeared that the complainant was not entitled to maintain its suit" (*Met. Co. v. Kaw Valley District, supra*), "review the whole of the interlocutory decree, not merely the part granting the injunction, and determine whether there was any insuperable objection, in point of jurisdiction or merits to the maintenance of the suit, and, if there was, to direct a final decree dismissing the bill". *U. S. Fidelity Co. v. Bray, supra*.

III.

All issues involved in this action are res adjudicata because of their adjudication in the Federal Courts of the Second Circuit.

After most of the testimony had been taken in said cancellation proceedings, said The Baldwin Company brought an action *in equity* against said R. S. Howard Company in the United States District Court, Southern District of New York. Certified copies of the pleadings and decree are a part of the records of this Court, and were put in evidence by The Baldwin Company. The Opinions and decree are in the record at bar (Rec.

pp. 4, 5, 44-53) and show that this action was brought:

- (a) for infringement of the said two trade-mark registrations No. 31,411 and No. 46,993, and praying for three-fold damages for their infringement;
- (b) to enjoin unfair trade competition based on common law rights to the name "Howard" as a common law mark for pianos;
- (c) to enjoin said R. S. Howard Company from further prosecuting said cancellation proceedings respecting said two trade-mark registrations, "or any other application for the cancellation" of said trade-mark registrations.

As shown by said Opinions (Rec. pp. 44-53), the claims for infringement of said trade-mark registrations were withdrawn at final hearing and no adjudication was made thereon. The United States Circuit Court of Appeals said (Rec. p. 53):

"At the final hearing below, plaintiff did not claim infringement of its registrations and confined its charge of infringement solely to its common law rights in the name 'Howard'".

The Courts in many cases have ruled that decisions "confined solely to the questions of unfair competition" are "a matter of no concern *** either by way of estoppel or otherwise" in cancellation or opposition proceedings.

See *Hercules Powder Co. v. Neuton*, 266 Fed., (C. C. A.) 169, which case thoroughly covers this

point, the Opinion of the Court being written by the same Judge who decided the Baldwin-Howard case in the District Court in New York.

Also:

In re Hoff, 30 App. D. C., 233;
Oliver Plow Works v. Oliver Co., 40 App. D. C., 125, 128.

It may be noted that in the decree in the New York case the word "mark" or "trade-mark" does *not appear*, and is nowhere used, but the decree is that The Baldwin Company has the right to use the name "'Howard' as a name for its pianos", and that the R. S. Howard Company has the right to use "Howard", with the prefix "R. S." or "Robert S." and the suffix "Company" or "Co.", on its pianos, and as its business and corporate name (Rec. pp. 4, 5).

The Federal Courts in New York *refused* the injunctive relief there sought which is the *identical* relief now sought at bar.

A reference to the Opinions of the Federal Courts in New York (Rec. pp. 44-53) shows not only that an injunction "to prevent the continuance of the cancellation proceedings in the (Patent) Office" was pleaded and urged, but also that such injunction was *expressly denied*. The parties and the subject-matter were the same.

It is respectfully submitted that said adjudication by the Federal Courts in New York is *res adjudicata* of the whole contention and all issues involved in the case at bar.

In view of said decisions (as well as the adjudication of the Court of Appeals of the District of Columbia in said cancellation proceedings,

48 App. D. C., 437) respondent further expressly urges that The Baldwin Company has already entirely exhausted its remedies and that this controversy should now forthwith be terminated.

Certified copies of the pleadings, Opinions and Decrees of the Federal Courts in New York were put in evidence by The Baldwin Company and form a part of the records of this Court in said cancellation proceedings (256 U. S., 35, Nos. 113 and 139 October Term, 1919 pp. 2599-2646) and also in No. 916 October Term, 1916, petition for writ of certiorari, R. S. Howard Company, petitioner, vs. The Baldwin Company (pp. 1-53, 401-417).

Certified copies of Opinions and Decree are included in the record at bar at pages 4, 5, 44-53.

Every Court takes judicial notice of its own records; at least, in the same case.

Bienville Water Co. v. Mobile, 186 U. S., 212;

The Golden Gate, 286 Fed. (C. C. A.) 105, 106.

The Baldwin Company is Wholly Without Equity.

The Baldwin Company does not come into equity with clean hands, because both registrations were originally secured upon false affidavits.

This is conclusively shown by the admissions and testimony of the officers of The Baldwin Company, and admissions of the parties are competent. *Sutton v. Wentworth*, 247 Fed. (C. C. A.) 493.

As to Registration No. 31,411, the testimony of the officers of The Baldwin Company was that there had never been any statutory use of the mark shown in this registration prior to the application to register (Sargent's testimony, Rec. pp. 31, 32). Such statutory use is a prerequisite to a valid registration.

Elgin National Watch Co. v. Illinois Watchcase Co., 179 U. S., 665; *Bronson Co. v. Duell*, 17 App. D. C., 471.

The testimony of the officers of The Baldwin Company was that there had never been any "use" of the mark by The Valley Gem Piano Company (the registrant) *at any time*. The president of The Baldwin Company testified that The Valley Gem Piano Company (the registrant) never at any time had any factory, tools, machinery or equipment, had never at any time made pianos, sold pianos, or dealt in pianos (Armstrong's testimony, Rec. pp. 32, 33; also Sargent's testimony, Rec. pp. 31, 32).

The Baldwin Company claims its only title and rights to Registration No. 31,411, and to the mark therein shown, and to the name "Howard" as a mark for pianos, *solely* from and through The Valley Gem Piano Company, and as the assignee and successor to the business of The Valley Gem Piano Company (See The Baldwin Company's answers, Rec. pp. 21-23; affidavit of President Wulsin, Rec. p. 53-f).

Inasmuch as The Valley Gem Piano Company never did or could acquire any trade-mark rights (as it never had or did any business), it obviously follows that The Baldwin Company could not ob-

tain any rights or title from The Valley Gem Piano Company.

The testimony of the officers of The Baldwin Company was that the mark shown in Registration No. 31,411 was abandoned in 1912 with the intention never "to take it up again", and that The Baldwin Company has never used that mark since 1912 (Armstrong's testimony, Rec. pp. 32, 33; Sargent's testimony, Rec. pp. 31, 32; McGee's testimony, Rec. p. 36).

The Baldwin Company's right to Registration No. 46,993 was based solely upon Registration No. 31,411 and the use of the mark by, and its assignment from, The Valley Gem Piano Company. (See affidavit of President Wulsin, Rec. p. 53-f, forming a part of the application to register).

As The Valley Gem Piano Company had no trade-mark rights which it could transfer, The Baldwin Company's title to the mark not only must fail but the registration be held invalid because obtained by false affidavit and declaration.

The testimony of The Baldwin Company's officers was that whatever mark or marks containing the name "Howard" were used on pianos by any Baldwin concerns at any time prior to 1912 was not "Howard," but Heward in conjunction with the initials "VGPCo" arranged in a monogram. (Armstrong's testimony, Rec. pp. 32, 33; McGee's testimony, Rec. p. 36; Sargent's testimony, Rec. pp. 31, 32).

Hence it follows that there was no statutory use of "Howard" prior to the application to register the later registration, and as statutory use of a mark is a prerequisite to the right to

register, such registration was improperly granted and is invalid. "He can register only what he has used".

Elgin Nat'l Watch Co. v. Illinois Watch Case Co., 179 U. S. 665;
Corbin v. Gould, 133 U. S. 308;
Ammon & Person v. Narragansett Diary Co., 252 Fed. 276; aff. 262 Fed., 880;
Quaker City Flour Mills Co. v. Quaker Oats Co., 43 App. D. C., 260;
Hay v. Malone, 50 App. D. C. 399;
Bronson Co. v. Duell, 17 App. D. C. 471.

It is respectfully submitted that the action of The Baldwin Company, at bar, is wholly without equity.

The complete testimony of George W. Armstrong, Jr., Levi D. Sargent and Frank A. McGee was included in the record before the Supreme Court of the District of Columbia, and is summarized in the record at bar. George W. Armstrong, Jr., testified that he was one of the organizers of said The Valley Gem Piano Company and also of The Baldwin Company, and had been a director and officer of both Companies since their organization and was at the time he gave testimony the president of both said Companies. Levi D. Sargent testified that he was factory manager of The Ellington Piano Company, an Ohio corporation in whose factory all "Howard" pianos were made for the first several years, and was a director (and had been so for several years) of The Baldwin Company at the time he gave said testimony; Frank A. Mc-

Gee testified he was a director and the Auditor of The Baldwin Company at the time he gave said testimony and had been such for several years. The complete testimony of these witnesses is on file in this Court in Nos. 113 and 139, October Term, 1919.

"Damage" to R. S. Howard Company.

The complaint at bar is based upon the allegation that the R. S. Howard Company is not and cannot be damaged by said trade-mark registrations. It is respectfully submitted that the *fact* of whether or not the R. S. Howard Company is or can be damaged is wholly immaterial; the basis of the action at bar must be the affirmative right, "*according to law*", of The Baldwin Company to the registration of the personal name "Howard".

However, if it be held that the *fact* of whether or not the R. S. Howard Company is or can be damaged by said registrations is material, it is respectfully submitted that this fact appears in the Record, fully adjudicated.

Grounds of Damages to R. S. Howard Co.

The elements or grounds of injury and damage to the R. S. Howard Company may be summarized under the following heads:

1. The Record shows that The Baldwin Company has been sending threatening and intimi-

dating letters to respondent's customers claiming rights under trade-marks "duly registered by us in the United States Patent Office", and "will take all necessary steps to protect our rights against infringement". Samples of these threatening and intimidating letters are set out in the Record pp. 43, 44.

It is respectfully submitted that any use by the Baldwin Company of unlawful registrations of trade-marks which threatens damage or injury to, or unfairly obstructs or unlawfully interferes with, respondent's business is a continuing menace, injury and damage to respondent; that the direct and obvious purpose of the letters was to intimidate respondent's customers, threaten them with litigation, and cause them to cease to deal in respondent's pianos.

American Wells Works Co. v. Layne & Bowler Co., 241 U. S. 257;
Racine Paper Goods Co. v. Dittgen,
 171 Fed. (C. C. A.) 631;
Kidd v. Horry, 28 Fed. 773 (Mr. Justice Bradley);
Seattle Brewing Co. v. Hansen, 144 Fed.
 1011 and cases cited.

2. The Baldwin Company's threatened suit against respondent for infringement of said unlawful registrations constitutes a continuing threat of serious and permanent damage to respondent's business and an intimidation of its customers.

"The registration is itself a standing threat".
Denny Tag Co. v. Dennison Mfg. Co., 256 O. G. 221; aff. 48 App. D. C. 213.

Elgin Nat'l Watch Co. v. Illinois Watch-case Co., 179 U. S. 665;

Electro Steel Co. v. Lindenberg Steel Co., 43 App. D. C. 270;
Old Lexington Club D. Co. v. Kentucky D. & W. Co., 234 Fed., 464; Aff. 247 Fed. 1005;
Heaton-Peninsular Button Co. v. Independent Button Co., 43 App. D. C. 264.

3. Respondent has been adjudged entitled to use "R. S. Howard Co." as its business and corporate name and so to mark its pianos (Rec. p. 5).

Pianos bearing the name "Howard" or any name of which the name "Howard" formed a part, have always been called "Howard" pianos by everybody, because "Howard" was the dominant feature of the name on the fall-board. Prefixes and suffixes are entirely disregarded by the trade and public generally. (Judge Hough's opinion, Rec. p. 47; Mr. Steinway's testimony, Rec. p. 27; Mr. Dickinson's testimony, Rec. p. 34).

"It is the surname which catches the public, and few purchasers would notice the difference between one form and the other. In the nature of things confusion was inevitable". "Guth Chocolate Company" held to be an infringement and colorable imitation of "Guth". *Guth vs. Guth Chocolate Co.*, 224 Fed. (C. C. A.) 932.

"C. I. Davids Co." and "Davids Mfg. Co." were held by this Court to be infringements of the registered mark "Davids". This Court said:

"The use of the name in this manner was a mere simulation of the complainant's mark

which it duly registered; it constituted a 'colorable imitation' within the meaning of the Act. * * * We agree with the Circuit Court that infringement is shown". *Thad. Davids Co. v. Davids*, 233 U. S. 461, 469.

"William P. Stark Nurseries" held to infringe the registered trade-mark "Stark Trees". *William P. Stark vs. Stark Bros.*, 257 Fed. (C. C. A.) 9.

"Tucker" and "J. C. Tucker" held similar and confusing. *Brown-Forman Co. v. Beech Hill Dist. Co.*, 30 App. D. C. 485.

"Taylor", "Old Taylor", "G. A. Taylor", "Kentucky Taylor", are all held to be similar and confusing. *In re Wright*, 33 App. D. C. 510.

"Hoff" and "Leopold Hoff" held so similar as to create confusion. *In re Hoff*, 30 App. D. C. 233.

4. Said registrations being *prima facie* evidence of *exclusive ownership* of *valid trade-mark* of the personal name "Howard", the Baldwin Company would *prima facie* be entitled to the exclusive use of "Howard" *in any form, and in every form*, whether used with or without prefixes or suffixes.

Thad. Davids Co. v. Davids, 233 U. S. 461;

Shredded Wheat Co. v. Humphrey Cornell Co., 250 Fed. (C. C. A.) 960;

Elgin Nat'l Watch Co. v. Illinois Watch-case Co., 179 U. S. 665.

5. Respondent is damaged by the registration of the personal name "Howard", the dominant feature of its corporate name.

As the Baldwin Company has no exclusive right to the personal name "Howard", damage and injury to respondent is implied, as a matter of law, by the improper registration of the dominant and distinguishing features of respondent's corporate name. Respondent was incorporated in 1902, appellant did not make statutory use of "Howard" prior to 1912. (Sargent's testimony Rec. pp. 31, 32).

Mansfield Tire & Rubber Co. v. Ford Motor Co., 44 App. D. C. 205;
Investor Pub. Co. v. Dobinson, 72 Fed. 603, 606 and cases cited.

6. Respondent is irreparably damaged in its foreign business by the Baldwin Company's foreign registrations of "Howard" which foreign registrations the Baldwin Company admits in its complaint (Rec. p. 8, par. 11) it has registered, basing such foreign registrations in some fifteen foreign countries on certified copies of said Registration No. 46,993 (Donegan's testimony, Rec. p. 30).

The Record shows, without contradiction, that respondent since 1902 has been doing an extensive foreign business in a long list of foreign countries (Marken's testimony, Rec. p. 26; Stower's testimony, Rec. p. 26; Barber's testimony, Rec. p. 28). The undisputed testimony is that in most, if not all, Spanish speaking and South American countries infringement of a reg-

istered trade-mark is a criminal and penal offense, subjecting dealers to the penalty of fine and imprisonment and the goods bearing the infringing mark to confiscation (Stower's testimony, Rec. p. 26; Barber's testimony, Rec. p. 28); that in Spanish speaking countries the distinction between a trade-mark and a trade-name is not understood or not recognized; that this same confusion and failure to distinguish between a trade-mark and a trade-name is found in all countries; that "the timidity of dealers in the handling of goods, the trade-name or trade-mark on which is questioned, or is the subject of dispute, is very well recognized in all countries"; that in Spanish speaking and South American countries what may be considered a "similar" marking is quite indefinite and undeterminable, but that any mark bearing any dominant feature of a registered mark would probably be considered "similar" and an infringement, with little hope of securing from any Court the right to sell under a business or trade-name which in any degree bore resemblance to a registered trade-mark. (Barber's testimony, Rec. pp. 27-30).

The distinction pointed out in some American and English decisions between a trade-name and a trade-mark is not generally recognized by dealers, the public or even by the Courts; even the American and English Court decisions are full of such confusion.

"The terms 'trade-mark', 'trade-name' and 'technical trade-mark' are confused constantly, both in Court opinions and in the public press. This confusion is natural, and arises out of the manner in which the law of trade-marks has been developed in English

and American jurisprudence * * * Much confusion exists due to the loose use to which it (the term 'Trade-mark') is constantly put in legal literature". *Nims, on Unfair Competition and Trade-Marks*, p. 372-5 (2nd Ed.).

Furthermore, it is respectfully submitted, the fact that respondent is damaged and injured by said trade-mark registrations was fully adjudicated and established in said Cancellation proceedings, and that said adjudication should now be accepted as fully establishing such fact.

**Sec. 4915 R. S. Should not be Extended
by "Interpretation".**

In *Morgan v. Daniels*, 153 U. S. 120, 124, which was an action for a patent under Sec. 4915, the Court said:

"But this is something more than a mere appeal. * * * It is something in the nature of a suit to set aside a judgment, and as such is not to be sustained by a mere preponderance of evidence. *Butler v. Shaw*, 21 Fed. Rep. 321, 327. It is a controversy between two individuals over a question which has once been settled by a special tribunal entrusted with full power in the premises. As such it might be well argued, were it not for the terms of this statute, that decision was a finality upon every matter of fact. *Johnson v. Towsley*, 13 Wall, 72, 86".

The Court of Appeals in the First Circuit, in *Greenwood v. Dover*, 194 Fed. (C. C. A.) 90, 94, an action for a patent under Sec. 4915 R. S., said:

"It is to be regretted that Congress has not provided that decisions like that in the Court of Appeals (of the District of Columbia) in *Greenwood v. Dover* should be conclusive, in the same way in which any decisions of the Superior Courts of federal or state jurisdiction are ordinarily held effectual. * * * they have all the elements of the fundamental principles of the 'law of the land', and might well have been pronounced by Congress to end the litigation accordingly, and thus to avoid the opportunity of further holding up of patents, and of leaving the rights of both the public and the patentee indecisive for another series of years. The entire proceeding contains the great elements required by the 'law of the land', namely, opportunity for both parties to be heard, and finally a decision by a Court of high authority, endowed with all machinery of Superior Courts of Judicature. As it is, however, we are compelled to accept in this single particular the view claimed by Dover, that the judgment of the Court of Appeals stands akin to a departmental decision, although no court could avoid the impression that in a certain sense and to a certain extent it is of greater weight. It is sufficient for us, however, to apply to this case the rule of *Morgan v. Daniels*, that there must be a clear conviction on this record

proceedings had been certified to the Commissioner of Patents, as provided by Sec. 4914 Rev. Stat., The Baldwin Company filed its bill of complaint, at bar, against the Commissioner of Patents, in the Supreme Court of the District of Columbia, alleging that it would be damaged by the cancellation of said trade-mark registrations and that the said R. S. Howard Company had not been, and could not be, damaged by said trade-mark registrations, and prayed that the Commissioner of Patents be enjoined from cancelling said trade-mark registrations, *pendente lite* and perpetually.

The claim for such injunction was based wholly upon the allegations that the R. S. Howard Company is not, and could not be, damaged or injured by said Trade-Mark Registrations, and that The Baldwin Company is entitled to have this claim "judicially determined" under Sec. 4915 U. S. Rev. Stat.

The grounds alleged for such an injunction are identical with those alleged, and adjudicated adversely to The Baldwin Company, in said Cancellation proceedings of *R. S. Howard Company vs. The Baldwin Company* (48 App. D. C. 437; Rec. pp. 61-65; 256 U. S. 35), and the relief prayed for at bar is the same relief which was *expressly denied* to The Baldwin Company in the Equity suit in the Second Circuit of *The Baldwin Company v. R. S. Howard Company* (See pp. 26-29, *infra*).

Motion to Dismiss.

The R. S. Howard Company intervened in the action at bar, filed its answer, and moved to dismiss the bill of complaint on the following grounds (Rec. p. 65) :

- (a) That the bill was bad in substance and insufficient in law;
- (b) That the Supreme Court of the District of Columbia was without power or authority to grant the relief prayed for, or any relief in the premises;
- (c) That all issues involved in the action were *res adjudicata* as appeared from the allegations and admissions contained in the bill of complaint and the matters of record filed as a part of the answer of the R. S. Howard Company.

All the separate grounds, above stated, were urged and argued at length, below, and unmistakably show a want of equity

Respondent urges that if the ground of the decision below is not well taken, the record discloses other good and sufficient grounds. *Cole v. Ralph*, 252 U. S. 286, 290.

I.

The complaint is bad in substance and insufficient in law.

The complaint fails to state a good cause of action.

that the conclusion of the Court of Appeals was erroneous.” * * *

“The conclusion in *Morgan v. Daniels* was not a peculiar outgrowth of the patent system. It was simply a phase of the general rules with reference to the determinations of the executive departments, where the statutes authorize them to investigate and decide questions of fact preliminary to a grant on which private rights are to rest. We need cite in this particular only the *Maxwell Land Grant* case, 121 U. S. 325, 7 Sup. Ct. 1015, 30 L. Ed. 949 and *United States v. Bell Telephone Company*, 167 U. S. 224, 17 Sup. Ct. 809, 42 L. Ed. 144”.

See also Judge Aldrich’s concurring Opinion (same case p. 97), but to the effect that an action under Sec. 4915 R. S. should only be possible and the decision of the Court of Appeals of the District of Columbia should not be disturbed

“except upon a bill which states a case for equitable relief and a case so clear upon the evidence as to show that the results were promoted by fraud, accident or mistake”, that is, upon the same basis as general property rights are safeguarded. And that “where questions of fact have been determined and established by such a court of competent jurisdiction, in an inter partes case, that the result of the decision will not be overthrown except upon such grounds as relief is granted from judgments at law and decrees in equity, under the broad sense in which equity and common law jurisdi-

tions are understood in this country and in England."

Judge Aldrich also points out that Sec. 4915 R. S. is a statute that has come down to us without substantial change from a time when there was no judicial review of decisions of the Commissioner of Patents. Its language may be traced back to the Patent Act of 1836 when there was created an appeal to a board of examiners composed of three disinterested persons whose decision was to be certified to the Commissioner of Patents who "shall be governed thereby in the further proceedings to be had on such application". (*U. S. v. Duell*, 172 U. S. 576). It was not until 1870 that a judicial review of the Commissioner's decisions was provided, by an appeal to the Supreme Court of the District of Columbia sitting in bane, and not until 1893 that a judicial appeal was allowed in interference cases (probably the most important class of Patent cases). It is yet authoritatively to be determined whether or not it is necessary to appeal to the Court of Appeals of the District of Columbia before bringing action under Sec. 4915 R. S.

The United States Circuit Court of Appeals in the Second Circuit in *Gold v. Newton*, 254 Fed. 824, 827, which was an application for a patent under Sec. 4915 after refusal by the Court of Appeals of the District of Columbia, in which it was urged that the proceeding was not an appeal but an original action, said:

"In form this is true, but in substance we do not think it is. * * * In respect to actions like this, solely against the Commissioner,

that the conclusion of the Court of Appeals was erroneous." * * *

"The conclusion in *Morgan v. Daniels* was not a peculiar outgrowth of the patent system. It was simply a phase of the general rules with reference to the determinations of the executive departments, where the statutes authorize them to investigate and decide questions of fact preliminary to a grant on which private rights are to rest. We need cite in this particular only the *Maxwell Land Grant* case, 121 U. S. 325, 7 Sup. Ct. 1915, 30 L. Ed. 949 and *United States v. Bell Telephone Company*, 167 U. S. 224, 17 Sup. Ct. 809, 42 L. Ed. 144".

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"In form this is true, but in substance we do not think it is. * * * In respect to actions like this, solely against the Commissioner,

the jurisdiction still existing under R. S. Sec. 4915 (Comp. St. Sec. 9460, is, to say the least, a singularity in law making. * * *

"Further, a Court appealed to under Sec. 4915 must by the evidence shown it, whether new or old, be very fully and amply persuaded of plaintiff's merits before granting relief. * * *

"But, in a proceeding under Sec. 4915, (for a patent) * * * the Court * * * must treat the conclusions * * * of the Court of Appeals as a finding of a tribunal having jurisdiction with matters determined in the Patent Office, and upon appeal therefrom, and insofar as these determinations are shown to have been made upon the same facts as those presented to the Court in the action under Section 4915, they should not be disturbed unless shown to be plainly and unmistakably erroneous. * * * All reasonable doubt must be removed and thorough conviction must be had".

General Elec. Co. v. Steinberger, 208 Fed. 699, 700.

In *Richards v. Meissner*, 163 Fed. 957, 960, which was an action for a patent under Sec. 4915 the Court said:

"It is a rule well-nigh or quite universal in its application and enforcement that, when questions of fact are submitted for finding to an officer or tribunal, such findings of fact, when free from fraud, accident, or mistake, are conclusive, and cannot be modified or

set aside by a court, provided always that the officer or tribunal had the statutory authority to make such findings pursuant to official duties". * * *

"But for Section 4915 of the Revised Statutes no one could doubt but that the decision of the Court of Appeals for the District of Columbia was the end of the litigation, because that Court had jurisdiction of the subject matter and of the parties thereto, who with their privies are now before this Court litigating the same questions as in that Court litigated; and the force of this is not lessened from the fact that there is no provision for an appeal from that Court to the Supreme Court, because the right to an appeal is not a common-law right, but can only exist when expressly conferred by statute, so that the decision of the District of Columbia Court is *res adjudicata*, except as controlled by Section 4915 of the Revised Statutes". (McPherson, J.)

To same effect in same case, 158 Fed. 109 (Philips, J.)

In view of the foregoing citations (and others which might be quoted), it would seem unnecessary, if not undesirable, to extend, to *any extent*, the application of Section 4915 R. S.; and even though Sec. 4915 R. S. be extended to securing the registration of trade-marks, it would seem quite beyond the power of the Court to extend this Section to the *cancellation* of trade-mark registrations. It might be said, as stated by this Court in *Butterworth v. Hoe, supra*, where the

issue was whether or not the Secretary of the Interior could review a decision of the Commissioner of Patents, if Congress had intended Section 4915 R. S. to apply to trade-marks it would have included such provision in the Section.

The present Trade-Mark Act has been passed, and amendments in several particulars have been made from time to time since its passage; it is respectfully submitted that if Congress had deemed it desirable that trade-marks should be included in Section 4915 R. S. it would have so provided. Such provision would appear necessary as respects the *cancellation* of a trade-mark registration inasmuch as Section 4915 R. S. does not apply to the *cancellation* of a patent.

To include in Sec. 4915 R. S. the *cancellation* of a trade-mark registration requires the incorporation into the Section of words entirely foreign to its present plain language.

Congress Refused a Section Similar to 4915 R. S.

A provision similar to Section 4915 R. S. was recommended to Congress by the report of the Commission appointed by the President to revise the Trade-Mark Laws (Senate Document No. 20, 56th Congress), which report became the basis of the present Trade-Mark Act (See H. R. Report No. 3147, 58th Congress). Notwithstanding such recommendation, **Congress refused to include such Section in the Trade-Mark Act**, which would appear clearly to indicate that it was not the intention of Congress to apply provisions similar to Section 4915 R. S. to trade-marks.

Section 9 of the Trade-Mark Act of 1905.

Section 9 of the Trade-mark Act of 1905, by its plain language, as well as its history (see H. R. Report No. 3147, 58th Congress, third Session) applies *only* to proceedings on appeal from the Patent Office to the Court of Appeals of the District of Columbia respecting trade-marks; that is, respecting registration, interference, opposition, and cancellation of trade-marks.

In the face of its plain language, this Court is now asked to hold that an action by bill in equity under Sec. 4915 R. S. (extended by said Sec. 9 through some occult interpretation) is provided in trade-mark registration proceedings, in trade-mark interference proceedings, in trade-mark opposition proceedings, and in proceedings to cancel trade-mark registrations. It is respectfully submitted that this is preposterous and a stretching of the wording of said Section beyond all reason, constituting a judicial interpretation running contrary to every reasonable presumption of Congressional intention.

Reference is again made to the exhaustive discussion of said Sec. 9 which is contained in the Opinion of the Court below (Rec. p. 79).

The Section Rejected by Congress.

The section of the proposed Trade-Mark Act recommended by said committee, but rejected by Congress, read as follows:

"Sec. 20. Whenever registration on application is refused, either by the Commissioner

of Patents, or by the Court of Appeals of the District of Columbia upon appeal from the Commissioner, or by the Supreme Court of the United States upon appeal from the Court of Appeals of the District of Columbia, the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to registration of the mark for which he has applied. If such adjudication be in favor of the applicant, the Commissioner shall register the mark upon the applicant filing in the Patent Office a copy of the adjudication, and otherwise complying with the requirements of law. In all cases, where there is no opposing party, a copy of the bill shall be served on the Commissioner; and all the expenses of the proceeding shall be paid by the applicant, whether the final decision be in his favor or not." (Senate Document, No. 20, 56th Congress, 2nd Session, pp. 70, 71).

Prior to the Trade-Mark Act of 1905, no appeal or review (judicial or otherwise) from the decisions of the Commissioner of Patents was provided in trade-mark cases, either as to registration or interference; oppositions to registration were included in interferences; there were no provisions for cancellation of a trade-mark registration.

It is submitted, most respectfully, that to extend jurisdiction under Sec. 4915 R. S. to trademark cancellation proceedings would be judicial legislation of the broadest character, and legislation which Congress refused after the same had been recommended to it by a Committee expressly created by Congress to formulate a Trade-Mark Act.

Respectfully submitted,

R. S. HOWARD COMPANY,
by Samuel S. Watson,
Its Attorney,
2 Rector Street,
New York City, N. Y.

(5838)

POLLED

JUN 4 1932

W. R. STANSB

CLE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1932.

No. [REDACTED] 251

THE UNITED STATES OF AMERICA, *v.*
FELTON & THE BALDWIN COMPANY, AP-
PELLANT,

v.

THOMAS E. ROBERTSON, AS COMMISSIONER OF
PATENTS, AND R. S. HOWARD COMPANY,

ON APPEAL FROM THE COURT OF APPEALS OF THE
DISTRICT OF COLUMBIA.

BRIEF IN OPPOSITION TO MOTION TO AFFIRM DE-
CREE APPEALED FROM OR TO DISMISS THE
APPEAL.

John E. Goss,
John Spalding Flanagan,
Frederick D. McKenney,
Attorneys for Appellants.

LAWRENCE MAXWELL,
Of Counsel.



SUPREME COURT OF THE UNITED STATES.
OCTOBER TERM, 1922.

No. 918.

**THE UNITED STATES OF AMERICA, EX
RELATIONE THE BALDWIN COMPANY, AP-
PELLANT,**

vs.

**THOMAS E. ROBERTSON, AS COMMISSIONER OF
PATENTS, AND R. S. HOWARD COMPANY.**

**ON APPEAL FROM THE COURT OF APPEALS OF THE
DISTRICT OF COLUMBIA.**

**BRIEF IN OPPOSITION TO MOTION TO AFFIRM DE-
CREE APPEALED FROM OR TO DISMISS THE
APPEAL.**

Short Statement.

Subsequent to the rendition by this court of its opinion and decision in *The Baldwin Company v. R. S. Howard Company*, 256 U. S., 35 (wherein the general character of the controversy between these

parties with its antecedent history is sufficiently stated), The Baldwin Company filed in the Supreme Court of the District of Columbia its bill in equity against Thomas E. Robertson, as Commissioner of Patents, to restrain cancellation of the two registered trade-marks which the Company had long used in its business of manufacturing and selling pianos, and which constituted a valuable component of its good will asset. Such action was based upon section 4915 of the Revised Statutes of the United States, as construed and applied by this court in *Gaines v. Knecht*, 212 U. S., 561; *Atkins v. Moore*, 212 U. S., 285, 290, and in *Baldwin Co. v. Howard Co.*, 256 U. S., 35, above referred to (R., 1-10).

Defendant Robertson, answered admitting all pertinent averments of fact contained in the plaintiff's bill, but asserting that he was bound by the previous decision of the Court of Appeals of the District of Columbia, reported in 48 Appeals D. C., 437, prayed that the relief by injunction sought by plaintiff be denied and that the bill be dismissed (R., 11-12).

R. S. Howard Company was granted leave "to intervene as a defendant" (R., 10) and filed an elaborate answer (R., 12-66) and at the same time filed a motion to dismiss the bill of complaint, upon the ground, among others, that the Supreme Court of the District of Columbia was "without power or authority to grant the relief prayed for or any relief in the premises" (R., 66).

The matter was brought before the trial court on application by plaintiff for preliminary injunction, and on motion by defendant R. S. Howard Company to dismiss; defendant Commissioner of Patents submitting to "such action as the court might deem proper" (R., 71-middle).

After hearing, the learned trial justice (Hoehling, Asso. Jus.) said (R., 72):

"* * *; in view of the further holding of said Supreme Court (United States) that sections 4914 and 4915, R. S. U. S. are applicable in trade-mark cases, and finally, in view of the express holding of the Supreme Court that this case is controlled by the principles so announced, the conclusion seems necessarily to follow that the Supreme Court, having before it an application to review the adverse holding of the Court of Appeals, *supra*, and finding itself without jurisdiction to entertain the same, either on appeal or by certiorari; nevertheless, in direct and express terms and language, pointed out a method and way in which such judicial review of the questions might be secured.

"If that be not the true intent and meaning of the decision of that court, then the language of the opinion must be denied its ordinary, plain, and usual meaning."

"If, therefore, there be open to the plaintiff, Baldwin Co., an opportunity for judicial review of the questions raised in this suit, under said sections 4914 and 4915, R. S. U. S., and the Supreme Court apparently has so held; then pending the proceeding,

the status of the subject-matter of the litigation should be preserved unimpaired; since the remedy so given would be futile if, pending the proceeding, the trade-mark registrations be permitted to be canceled.

"Accordingly, the court is of opinion that the motion of defendant, Howard Co., to dismiss should be overruled, and that the application of plaintiff, Baldwin Co., for preliminary injunction should be granted. Appropriate order in that behalf may be prepared by counsel and submitted, upon due notice."

A decree overruling intervenor R. S. Howard Company's motion to dismiss, and granting plaintiff, Baldwin Company's application for injunction, *pendente lite*, restraining the Commissioner of Patents and his subordinates "pending final decision of this cause," was duly entered (R., 73-74).

From such decree both defendants, R. S. Howard Company and the Commissioner of Patents prayed appeals to the Court of Appeals of the District of Columbia.

In the latter court the matter was heard on the "special appeal" (27 Stats., 436) of defendant, R. S. Howard Company (R., 79).

As specifically stated in the opinion of the Court of Appeals of the District of Columbia (Smyth, Ch. J.):

"The case turns upon the jurisdiction of the Supreme Court of the District to entertain the suit. Registration of trade-marks,

opposition to registration, cancellation of registration, and interference proceedings are all governed by statute (33 Stat., sec. 724, *et seq.*). The solution of any question which arises with respect to these matters must be in harmony with the terms of the statute (citing cases). If there is no statutory authority for bringing the suit, then the action of the lower court must be reversed and the amended bill dismissed" (R., 79, *et seq.*).

After discussing at some length the relative characteristics of letters patent and trade-marks under the United States statutes and the existence or absence of "property right" in each, and after reviewing the opinions of this court in *Atkins & Co. v. Moore*, and *Baldwin Co. v. Howard Co., ubi supra*, the learned chief justice of the Court of Appeals concludes discussion with the statement that (R., 83)

"The (Supreme) Court had no occasion to determine whether section 4915 gave a defeated applicant for (trade-mark) registration the right to commence a proceeding in equity, and we do not think it intended to so decide. * * * In other words, the questions of registration, cancellation, opposition, and interference in trade-mark cases are ended by our decision. * * *

"Believing that there is no authority for the maintenance of this suit, we reverse the decision appealed from and remand the case with instructions to dismiss the suit" (R., 83, 84).

From such conclusion and also from the reasoning of the majority opinion, Mr. Justice Robb dissented (R., 83-84).

To review this decree dismissing the bill of complaint for want of jurisdiction on part of the court of first instance to entertain it, The Baldwin Company prayed an appeal to this Honorable Court under provisions of section 250 of the Judicial Code.

While this case primarily involves rights under the trade-mark laws, such rights are sought to be enforced by invoking the remedial provisions of section 4915, R. S. U. S., one of the patent laws of the United States, and consequently it may be thought that the exception following paragraph "sixth" of section 250 of the Judicial Code providing for review in "cases arising under the patent laws," only "as provided in the next succeeding section," *i. e.*, section 251, by certiorari applies.

United States v. Ewing, Comr., etc., 237 U. S., 197.

Hutchinson v. Loewy, 217 U. S., 457.

Gompers v. United States, 233 U. S., 604.

And by way of analogy see

Macfadden v. United States, 213 U. S., 288.

A petition for certiorari also was filed herein and submitted to this court for its action on May 21, 1923.

On said last-mentioned date this court delivered

its opinion and passed its decree in *American Steel Foundries v. Robertson*, Commissioner of Patents and *Simplex Electric Heating Company*, No. 291, October term, 1922, wherein it is said:

“It is pressed upon us, however, that this language in *Atkins v. Moore* and in *Baldwin Co. v. White Company*, was not necessary to the conclusion in those cases and is to be regarded as *obiter dictum*. It was used in *arguendo* and was the unanimous expression of the court in both cases. It may be that the conclusion that the decision of the Court of Appeals was not final and applicable to this court could have been reached without this argument; but, however this may be, the construction put by the court on section 9 is most persuasive and follows so clearly from the decision in *Gandy v. Marable*, that we find no reason to question its correctness.

“An argument has been made to us against giving such an effect to section 9, based on the intrinsic differences between the nature of the patent right, and that in a trade-mark. We do not regard such differences as important in interpreting section 9 when it is obvious from that section and the whole of the Trade-Mark Act that Congress intended to produce a parallelism in the mode of securing these two kinds of government monopoly from the Patent Office.”

As result of the reasoning and conclusions so expressed and the decree passed in that case, the question as to the jurisdiction of the Supreme

Court of the District of Columbia, to maintain the bill in equity herein is no longer doubtful.

As the jurisdiction of the Supreme Court of the District of Columbia was specifically put in issue in that court and was the only question passed upon both in that court and in the Court of Appeals of the District of Columbia, it seems quite clear that both the motion to dismiss The Baldwin Company's appeal or affirm the decree of the Court of Appeals of the District of Columbia must be denied.

As such denial inevitably disposes of the single question presented by this record for consideration, it would seem that in the interest of conserving the time of this Honorable Court and of speeding this cause to final determination, the decree of the Court of Appeals of the District of Columbia should be reversed and the cause remanded to that court with instructions to further remand same to the Supreme Court of the District of Columbia for further proceedings to be had therein in due and ordinary course.

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